

REMARKS

Claims 1-54 are pending. Claim 6 has been amended in this response. Claims 1-5 and 11-53 have been withdrawn without prejudice, waiver, or disclaimer. Claim 54 has been added. No new matter is believed to be added by this amendment. In addition, unless a passage of an amendment is specifically discussed below in connection with one or more cited references, Applicant respectfully submits that the amendments to the claims should be constructed as being submitted merely to clarify the invention rather than as a limitation submitted to overcome a cited reference.

A. Claim Rejections under 35 USC §101

The Examiner rejected the claims as being directed to non-statutory matter. More particularly, the Examiner determined that Claim 6-10 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims. In response, Applicant has amended independent Claim 6 to include the step of “employing a data processing system. . .” Thus, Applicant has positively recited technology in the body of the claim.

B. Claim Rejections under 35 USC §112

The Examiner rejected Claims 6-10 as being indefinite. In particular, the Examiner noted that it was not clear as to whether the claimed invention was a method or an apparatus. In response, Applicant has amended the preamble of Claim 6 to clearly express the claimed invention is a method. As currently amended, the preamble of Claim 6 reads as follows: “A retirement planning method for computing a possible future value of a portfolio of a plurality of joint investors, comprising . . .”

C. Claim Rejections under 35 USC §103(a)

Claims 6-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent No. 6,012,044 to Maggioncalda et al. (“Maggioncalda”) in view of U.S. Patent No.

5,148,365 to Dembo ("Dembo") and further in view of U.S. Patent No. 5,930,760 to Anderton et al. ("Anderton"). These rejections are respectfully traversed.

As currently amended, independent Claim 6 reads as follows:

6. A retirement planning method for computing a possible future value of a portfolio of a plurality of joint investors, comprising the steps of:
- employing a data processing system for:
 - (a) receiving user inputs comprising an initial value of the portfolio, a current age of a first joint investor, and a current age of a second joint investor;
 - (b) providing data indicating one of cumulative probabilities of living to an age of death and cumulative probabilities dying at an age of death for persons of a given age group;
 - (c) randomly drawing a number between 0 and 1 for the first joint investor;
 - (d) defining the randomly drawn number of step (c) as one of said one of cumulative probabilities of living to an age of death and cumulative probabilities of dying at an age of death for the first joint investor;
 - (e) determining an age of death of the first joint investor in accordance with said data, based on the current age of the first joint investor and the randomly drawn number of step (c);
 - (f) randomly drawing a number between 0 and 1 for the second joint investor;
 - (g) defining the randomly drawn number of step (f) as one of said one of cumulative probabilities of living to an age of death and cumulative probabilities of dying at an age of death for the second joint investor;
 - (h) determining an age of death of the second joint investor in accordance with said data based on the current age of the second joint investor and the randomly drawn number of step (f);
 - (i) determining the greater age of death of the first and second joint investors by comparing the age of death of the first joint investor determined in step (e) with the age of death of the second joint investor determined in step (h);
 - (j) computing a future value of the portfolio using said greater age of death of the joint investors, a predetermined rate of return, and the initial value of the portfolio; and
 - (k) outputting the computed future value of the portfolio.

Anderton is cited for teaching the use of mortality tables for determining the age of death. Maggioncalda discloses a data processing system for exploring how changes in one or more input decisions, such as, for example, risk tolerance, a savings level, and a retirement age affect one or

more output values such as a probability of achieving a financial goal or an indication of short-term risk. As admitted on Page 4 of the Office Action, Maggioncalda fails to disclose or suggest the steps of: providing data indicating one of cumulative probabilities of living to an age of death and cumulative probabilities dying at an age of death for persons of a given age group; randomly drawing a number between 0 and 1 for the first joint investor; defining the randomly drawn number as one of said one of cumulative probabilities of living to an age of death and cumulative probabilities of dying at an age of death for the first joint investor; determining an age of death of the first joint investor in accordance with said data, based on the current age of the first joint investor and the randomly drawn number; randomly drawing a number between 0 and 1 for the second joint investor; defining the randomly drawn number as one of said one of cumulative probabilities of living to an age of death and cumulative probabilities of dying at an age of death for the second joint investor; determining an age of death of the second joint investor in accordance with said data based on the current age of the second joint investor and the randomly drawn number; determining the greater age of death of the first and second joint investors by comparing the determined age of death of the first joint investor with the determined age of death of the second joint investor; and computing a future value of the portfolio using said greater age of death of the joint investors, a predetermined rate of return, and the initial value of the portfolio.

The Examiner relies on Dembo for teaching the steps of using simulation to determine the values of an output based on input values. Thus, the Examiner interprets Dembo as teaching the steps of determining the age of death of a first investor based on the current age of the investor and simulation based on a mathematical model and determining the age of death of a second investor using the same method. In fact, Dembo teaches a method of optimally allocating available resources in a physical system and includes the steps of assigning a value to each uncertain parameters in a mathematical model based on a scenario that is or may be expected to occur; solving the mathematical model for each scenario to determine the best solution for that particular scenario; assigning a probability value that represents the expected probability that the

scenario will occur to each solution of the mathematical model; and determining a single solution to the mathematical model that best models the desired physical system behavior under the uncertainty defined by all of the scenarios considered.

Nowhere in these portions or any other portion of Dembo is there a disclosure or suggestion of, for each individual investor of the joint investor, defining a selected random number between 0 and 1 as one of the cumulative possibilities of lining to an age of death and the cumulative probabilities of dying at an age of death. Further, there is no suggestion or teaching for determining an age of death of an investor in accord with the data – based on the current age of the investor and the randomly drawn number. In fact, there is no mention in Dembo of how an investor's age of death could be determined. Thus, a construction or interpretation of Dembo as using or teaching the steps of the present invention would require hindsight reasoning, which the Federal Circuit has explicitly rejected. *See In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) ("Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious."). Therefore, Dembo does not make up for the deficiencies of Maggioncalda, and Claim 6 is considered allowable over any combination of these patents.

If the position is maintained that the method steps recited in Claim 6 are shown by a combination of Maggioncalda, Dembo, and Anderton, Applicant respectfully requests that it be specifically pointed out where in the patents there is a basis for this view.

Dependent Claims 7-10 and 54 depend from Claim 6 and are considered allowable for at least the same reasons.


ATTORNEY DOCKET NO. 13170.0001U2
SERIAL NO. 09/625,702

Therefore, Applicants respectively request allowance of all the outstanding claims. The Examiner is invited and encouraged to contact directly the undersigned if such contact may enhance the efficient prosecution of this application to issue.

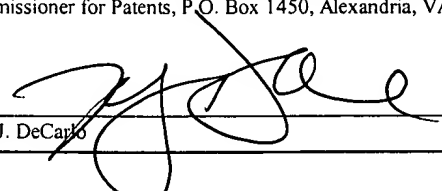
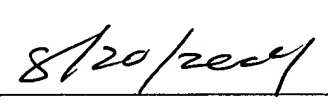
Payment in the amount of \$9.00 for the addition of 1 dependent claim is to be charged to a credit card and such payment is authorized by the signed, enclosed document entitled: Credit Card Payment Form PTO-2038. No fees are believed to be due; however, the Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.


Kean J. DeCarlo
Registration No. 39,956

Customer Number 23859
(678) 420-9300
(678) 420-9301 FACSIMILE

<u>CERTIFICATE OF MAILING</u>	
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA. 22313-1450, on August 20, 2004.	
 Kean J. DeCarlo	 Date

232150v1